

### **REMARKS**

The office action of April 11, 2008 finally rejects all claims as being obvious in view of various references, primarily U.S. Patent No. 6,115,510 to Koga (the "Koga reference"), U.S. Patent No. 6,950,203 to Akabane (the "Akabane reference"), and U.S. Patent Publication No. 2003/0197896 to Doyle (the "Doyle reference"). The applicants respectfully traverse these rejections.

#### **The Koga and Akabane references**

Claims 12, 18, 19, 24, 27-29, 30, 32, 35, and 36 were rejected as being obvious in view of the Koga and Akabane references. Likewise, claims 13-15, 20-23, 31, 33, 34, 37, and 38 were rejected as being obvious in view of the Koga and Akabane references in combination with various additional references. The applicants respectfully traverse the rejections and request reconsideration and review of this application in view of the following remarks and analysis.

A system according to various aspects of the present invention generates copies of documents and electronic images of the documents for later use. A scanning system generates physical copies of the documents as well as the electronic images for storage. The present system stores binding information for the original set of documents, which describes where and how the original documents were bound. For example, the system stores information indicating that pages 1 through 100 were held together with a binder clip, pages 2-8 were stapled together, and page 1 was clipped to pages 2-8 with a paperclip. With this information, not only can the original set of documents be duplicated, but the organization of the original documents may be duplicated as well.

Claim 12 refers to a method of making images of a collection of documents. The claimed method includes storing binding information and descriptive data pertaining to the collection of documents in a long-term memory, and storing the electronic images at a storage location in the long-term memory.

Claim 24 claims an imaging system including a scanner and a control system. The scanner may generate a collection of electronic images of a set of documents, and the control system substantially concurrently stores the collection of electronic images, binding information for the set of documents, and organizational data pertaining to the set of documents in a long-term memory.

These independent claims and various dependent claims stand rejected as being obvious in view of the Koga and Akabane references, as well as assorted other references for subject matter of various dependent claims. In particular, the office action indicates that the Koga reference discloses every claimed element other than long-term memory, which is disclosed on the Akabane reference. The office action concludes that the claimed subject matter would be obvious.

To reject a claim based on this rationale, the office action must resolve the Graham factual inquiries, i.e., determine obviousness according to (1) the scope and content of the prior art, (2) the level of ordinary skill in the art, (3) the differences between the prior art and the claimed invention, and (4) the extent of any objective indicia of nonobviousness. Then, the office action must articulate the following:

(1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;

(2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately;

(3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and

(4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

MPEP 2143(A). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done, and cannot rely on the applicant's disclosure. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. In *KSR v. Teleflex*, the Court notes that "a patent composed of several elements is not proved obvious by merely demonstrating that each of its elements was, independently, known in the prior art." *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Additionally, the Court cited *In re Kahn* stating that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

In the present case, the office action fails to meet these criteria. For example, the cited references do not include each element claimed, and the elements do not merely perform the same functions as they do separately. Further, the references do not expressly or impliedly suggest the claimed invention, and the office action fails to present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

For example, the Koga reference discloses a copy system including a stapler and a sorter. When the copier generates a copy, an image is shown on a CRT with a mark indicating a position for the staple. An operator checks the staple position and either adjusts it or accepts it. The stapler staples the printed sheets in the sorter at the designated stapling position(s). The Koga system is designed to prevent the copies from being stapled at a position other than as desired by the operator. Other than processing binding information and making copies, however, the Koga reference has nothing in common with the present application.

The Koga system does not store binding information for the original series of documents, and fails to store a sequence location for a binding element in the series of documents. The Koga reference does not store binding information for the series of documents, i.e., the original set of documents. Instead, the Koga reference allows the operator to select a position for the staple, which is selected according to the operator's desire, not according to the original series of documents. Thus, the Koga reference uses binding information based on the operator's selection, not the original set of documents to be copied. Again, this permits the original series of documents to be reconstructed from the information stored by the claimed system. The Koga system does not offer this capability, and the office action provides no discussion or disclosure whatsoever regarding this express element of the claims. Thus, the office action fails to include a valid finding that the prior art includes each element claimed.

#### The Koga, Akabane, and Doyle references

Claims 1-3, 5-9, 17, 39, 41-48, 51-53, 56-60, 63, 64, 67-71, 74, 76, and 78-82 stand rejected as being obvious in view of the Koga, Akabane, and Doyle references. The office action notes that the Koga and Akabane references fail to disclose a sequence location and a type of the binding element as claimed, and cites the Doyle reference as disclosing these elements. As evidenced by the attached Declaration of Dennis Brawn, however, the Doyle reference does not qualify as prior art and therefore does not support the rejections. Consequently, the rejections based on the Doyle reference should be

withdrawn. Likewise, the Jiang and Murata references do not qualify as prior art, and all rejections based on the Jiang and/or Murata references should also be withdrawn.

### **CONCLUSION**

Please consider the amendments and remarks. In view of the present amendments and comments, the applicant respectfully submits that the claims are in condition for allowance. Please contact the undersigned attorney at the address and telephone number noted below with any questions or comments.

Respectfully submitted,

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